UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,157	11/22/2000	George Friedman	1206-00	7408

35811 7590 02/07/2007	**EXAMINER**
IP GROUP OF DLA PIPER US LLP	CALLAHAN, PAUL E
ONE LIBERTY PLACE	
1650 MARKET ST, SUITE 4900	**ART UNIT** **PAPER NUMBER**
PHILADELPHIA, PA 19103	2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/701,157	FRIEDMAN ET AL.
	Examiner	Art Unit
	Paul Callahan	2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 January 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-149</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5,8,66-70,95-97,108,129,130 and 148</u> is/are rejected.

7)☐ Claim(s) <u>6,7,9-65,71-94,98-107,109-128,131-147,149</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 November 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January

4, 2007 has been entered.

2.   Claims 1-149 are pending and have been examined.

Response to Arguments

3.   Applicant's arguments with respect to claims 1, 95, 129, and 148 have been

considered but are moot in view of the new ground(s) of rejection. .

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-5, 8, 66-70, 95-97, 108, 129, 130, and 148 are rejected under 35 U.S.C.

103(a) as being unpatentable over Schneck et al., US 5,933,498, and Lee et al., US

6,163,859.

As for claim 1, Schneck teaches a method for maintaining data security

(Abstract, comprising: creating a package comprising data bundled together with one or

more permissions for regulating use of the data (fig. 1, fig. 2 items 120, 122 124, col. 7

lines 1-55, col. 10 lines 43-43, fig. 3 items 130-145) the one or more permissions

comprising one or more usage rule sets (fig. 2 item 124, col. 7 lines 1-55, col. 10 lines

34-43, fig. 3 items 130-145); and providing a receiver for processing the package (col.

15 lines 20-63) and storing the data in a vault whose existence and contents are

invisible to a user (col. 16 lines 27-59). Schneck does not teach a comprising dedicated

hard drive space. However Lee does teach this step (fig. 1 item 106: Client Vault, col. 4

lines 10-21). Therefore it would have been obvious to one of ordinary skill in the art at

the time of the invention to incorporate this step into the system of Schneck. Motive to

make this combination is found in Schneck col. 20 lines 20-26 and col. 15 line 36 where

the use of a hard drive and a laptop computer are discussed as embodiments of the

access mechanism. Therefore Schneck does contemplate use of a hard drive for some

aspects of memory of the user access mechanism. It would be a simple step to dedicate

space on the hard drive of Schneck to serve as a vault. It would be desirable to do so

since one step in tamper prevention discussed by Schneck is erasure of data. A hard

drive would facilitate this.

As for claim 2, Schneck teaches a method according to claim 1, wherein the step

of processing the package further comprises opening the package and verifying the

receiver for processing of the package (col. 21 lines 55-65).

As for claim 3, Schneck fails to explicitly teach a method according to claim 2

further comprising searching for at least one driver for reading the package. However

Official Notice may be taken that such a step is old and well known in the art. It is very

common for an application, once opened by a processor, to seek a driver to implement

it. Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate this step into the system of Schneck. It would be

desirable to do so since this would facilitate opening of content data without the need for

user input.

As for claim 4, Schneck teaches a method according to claim 1 further

comprising detecting violation of said one or more permissions (col. 18 lines 10-60, col.

15 lines 20-25).

As for claim 5, Schneck teaches a method according to claim 4 wherein the step

of providing a receiver further comprises providing internal security (col. 15 line 50

through col. 16 line 20).

As for claim 8, Schneck teaches a method according to claim 5, wherein step of creating a package further comprises an executable for verifying the operation of the receiver when the package is opened (col. 21 lines 55-65).

As for claim 66, Schneck teaches a method according to claim 1, wherein the step of creating a package comprises: receiving a file of data for packaging (fig. 1 item 106, col. 9 lines 45-55); receiving a permissions database having one or more permissions associated with the file of data (fig. 1 item 116, col. 9 lines 45-55), the one or more permissions governing a client's use of the file (col. 10 lines 35-43, col. 10 line 59 to col. 11 line 3); generating a package global unique identifier (fig. 3 item 128, 132, col. 10 line 59 to col. 11 line 3) ; generating a package of data comprising the file, the one or more permissions and the global unique identifier (fig. 1 item 108, col. 10 line 59 to col. 11 line 3); encrypting the package (fig. 2, col. 12 lines 1-16) ; and generating a computer executable file comprising the encrypted package (fig. 1 item 108, col. 12 lines 1-16).

As for claim 67, Schneck teaches the method of claim 66 wherein the one or more permissions are selected from the group consisting an access count permission, an access time permission, an expiration date permission, an authorization date permission, a clipboard permission, a print permission, an unlimited access permission, an application permission, and a system-events permission (col. 23 line 1 through col. 24 line 67).

As for claim 68, Schneck teaches the method of claim 67 further comprising the step of setting a password for access to the computer executable file (col. 23 lines 37-43: No Child Access).

As for claim 69, Schneck teaches the method of claim 68 wherein the package of data further comprises a recipient global unique identifier and further comprising the step of receiving the recipient global unique identifier after the step of generating a package global unique identifier (fig. 1 item 108, col. 10 line 59 to col. 11 line 3).

As for claim 70, Schneck teaches the method of claim 69 wherein the package of data further comprises client software (col. 7 lines 35 and 36).

As for claim 95, the claim is directed towards the system that carries out the method of claim 1. Claim 95 recites substantially the same limitations as claim 1 and is therefore rejected on the same basis as is that claim.

As for claim 96, the claim is directed towards the system that carries out the method of claim 5. Claim 96 recites substantially the same limitations as claim 5 and is therefore rejected on the same basis as is that claim.

As for claim 97, the claim is directed towards the system that carries out the method of claim 4. Claim 97 recites substantially the same limitations as claim 4 and is therefore rejected on the same basis as is that claim.

As for claim 108, Schneck teaches a system according to claim 96 comprising: a machine readable medium having information packaging software that generates a computer executable file (col. 9 lines 45-55), comprising a package of information 9 LINES 45-67), the package of information comprising: a file of data; a permissions database having one or more permissions associated with the file of data (COL. 9 lines 45-67); an encryption software (col. 12 lines 1-16, col. 14 lines 6-15), a network in communication with the machine readable medium (col. 9 lines 40-45); a client computer system in communication with the network (col. 9 lines 40-45), the computer system adapted to receive the package of information and execute the computer executable file (col. 9 lines 40-45), the computer system having a client permissions database (col. 9 lines 55-60), and a vault adapted to receive the package of information (col. 16 lines 27-59).

As for claims 129, the claim is directed towards the computer program-product embodied in a memory medium that causes a processor to undertake the method steps set forth in claim 1. Claim 129 recites substantially the same limitations as claim 1 and is therefore rejected on the same basis as is that claim.

As for claims 130, the claim is directed towards the computer program-product embodied in a memory medium that causes a processor to undertake the method steps set forth in claim 4. Claim 130 recites substantially the same limitations as claim 4 and is therefore rejected on the same basis as is that claim.

As for claim 148, the claim is directed towards the system that carries out the method steps set forth in claim 1. Claim 148 recites substantially the same limitations as claim 1 and is rejected on the same basis as is that claim.

Allowable Subject Matter

6.   Claims 6, 7, 9-65, 71-94, 98-107, 109-128, 131-147 and 149 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PEC

2-2-07

EMMANUEL L. MOISE
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